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LC-355

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Steven J. Hemsen	)	Examiner: R. Blanton
	)	Group Art Unit: 1762
Application No.: 09/719,546	)	Confirmation No.: 9980
Filed: December 22, 2000	)	
For: MOBILE VESSEL METHOD AND SYSTEM FOR IMPREGNATING POROUS ARTICLES	)	June 10, 2004

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REPLY BRIEF

Sir:

This Reply Brief is submitted in triplicate in response to the Examiner's Answer (Paper No. 20040413) mailed April 16, 2004 in this application.

Appellant takes issue with remarks found in the Examiner's Answer. Specifically, on page 12, at the end of the first full paragraph, the Examiner states:

> While Kerns also provides that the resin in the vessels is used for encapsulating rather than impregnating, Kerns provides no indication or feature

> that would teach against using batch processing for various other materials.

It appears from reading this statement that the Examiner is suggesting that it is up to a patent Applicant to show that a reference cited as grounds for rejection does not "teach against" the factual basis purported to support an obviousness rejection. This is not the proper standard for measuring obviousness. It is not up to a patent Applicant to show that a reference does not eliminate the possibility of combining known elements in a certain way.

The Court of Appeals for the Federal Circuit has discussed many times the proper standard for examining inventions defined by way of combinations of old elements. For instance,

> Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art. *Environmental Designs, Ltd. v. Union Oil Co. of CA.*, 218 USPQ 865, 870 (Fed. Cir. 1983).

> Casting an invention as 'a combination of old elements' leads improperly to an analysis of the claimed invention by the parts, not by the whole. That is what seems to have happened here. The critical inquiry is whether 'there is something in the prior art as a whole *to suggest* the desirability, and thus

> the obviousness, of making the combination. *Custom Accessories Inc. v. Jeffrey-Allan Industries Inc.*, 1 USPQ2d 1196, 1198 (Fed. Cir. 1986)(citation omitted) (emphasis in original).

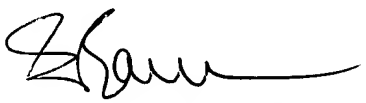
The suggestion to make the combination supporting the grounds of rejection must come from within the references themselves. However, the mere fact that those disclosures *can* be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination." *In re Imperato*, 486 F.2d 585, 179 USPQ 730, 732 (CCPA 1973) (citation omitted) (emphasis in original).

Kerns does not suggest the desirability of utilizing the combination of a vessel transporting process to impregnate a porous material with a flowable polymerizable compound, which would be the proper standard for determining obviousness. Whether Kerns "provides no indication or feature that would *teach against*" using other materials, as the Examiner asserts is not proper. Without such suggestion, Appellant maintains that there is no incentive to combine Kerns with what the Examiner has termed the Admitted State of the Prior Art. The rejection of Appellant's claimed invention based on this combination of references should therefore be reversed.

Based on the foregoing, reconsideration and withdrawal of the rejections of the pending claims and indication of their allowability is requested.

Applicant's undersigned attorney may be reached by telephone at (860) 571-5001, by facsimile at (860) 571-5028, or by email at steve.bauman@loctite.com. All correspondence should be directed to the address given below.

Respectfully Submitted,



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